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Attorney's Docket No. 5577-337/RSW920010175US1

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Bell *et al.*

Serial No.: 10/042,794

Filed: January 9, 2002

For: **EFFICIENT CONFIGURATION DATA MIGRATION TECHNIQUE**

Confirmation No.: 5106

Group Art Unit: 2192

Examiner: John J. Romano

Date: April 28, 2006

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Rosa Lee Brinson

APPELLANTS' REPLY BRIEF ON APPEAL UNDER 37 C.F.R. §41.41

Sir:

This Reply Brief is filed in response to the Examiner's Answer mailed February 28, 2006.

It is not believed that an extension of time and/or additional fee(s) are required, beyond those that may otherwise be provided for in documents accompanying this paper. In the event, however, that an extension of time is necessary to allow consideration of this paper, such an extension is hereby petitioned for under 37 C.F.R. §1.136(a). Any additional fees believed to be due in connection with this paper may be charged to Deposit Account No. 09-0461.

II. The Examiner's Answer – Response to Arguments (starting at Page 4)

Appellants will refrain here from readdressing all of the deficiencies with the pending rejections and, therefore, in the interest of brevity, Appellants hereby incorporate herein the arguments set out in Appellants' Brief on Appeal as if set forth in their entirety.

Accordingly, Appellants will only address new arguments made in the Examiner's Answer.

Appellants believe that the Board may find this helpful in evaluating the propriety of the pending rejections.

A. Claims 1, 10, 18 and 19

The Examiner's Answer first argues that Mackin teaches that the instruction to create the file comes from an external agent. *See* Examiner's Answer, page 4. The Examiner's Answer misinterprets Appellants' arguments. Appellants' argument is, in short, that Mackin does in fact discuss the use of OLE to implement some portion of (not necessarily the relevant portion of) the system discussed in Mackin and, therefore, the system discussed in Mackin may interact with a user interface, for example, a keyboard or mouse, but not necessarily to provide the relevant instruction. In other words, the discussion of OLE in Mackin is completely disjoint from the discussion of how the system of Mackin transitions configuration settings. The relevant portions of Mackin specifically recite that the system "automatically" transitions configuration settings from a source (old) computing system to a target (new) computing system. *See e.g.*, Mackin, column 4, lines 15-17: *see also*, Mackin, Title; Abstract; column 2, lines 46-55; and column 7, lines 12-14. Thus, nothing in Mackin discusses having the actual instruction that the first executable product provide a file containing selected configuration data come from an external agent as recited in Claims 1, 10, 18 and 19.

Accordingly, as a finding of anticipation requires that there must be no difference between the claimed invention and the disclosure of the cited reference as viewed by one of ordinary skill in the art (*See Scripps Clinic & Research Foundation v. Genentech Inc.*, 927 F.2d 1565, 1576, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)), Appellants respectfully submit that Claims 1, 10, 18 and 19 are not anticipated by Mackin for at least these additional reasons.

The Examiner's Answer further argues that because "the user interface application is used for preparing an extraction plan and a transition plan to extract and transition configuration settings from a source computer system for a target computer system" that the instruction is therefore given by an external agent. *See* Examiner's Answer, page 6. Appellants respectfully submit that "preparing an extraction and a transition plan" is not the same as implementing it, *i.e.* instructing. Accordingly, Appellants respectfully submit that Claims 1, 10, 18 and 19 are not anticipated by Mackin for at least these additional reasons.

B. Claim 3

The Examiner's Answer objects to Appellants' response to the Examiner's statements of inherency and common practice. *See* Examiner's Answer, page 7. However, Appellants submit that these statements could not be adequately responded to as the Actions did not provide any basis for such statements.

The Examiner's Answer further objects to Appellants' arguments with respect to Claim 3. Appellants maintain that Mackin does not disclose or suggest many of the recitations of Claim for at least the reasons set out herein and in Appellants' Brief on Appeal.

C. Claims 12, 13 and 17

The Examiner's Answer states Mackin discloses that "it is old and well known in the art to run batch files in order to '...save time, resources, improve transition quality, and reduce user frustration." *See* Examiner's Answer, page 9. Thus, the Examiner concludes that it would have been obvious to combine the references as suggested by the Examiner. Appellants respectfully submit that the case law is clear that the motivation to combine must be clear and particular. If this motivation provided by the Examiner were adequate, then any modification that saves time, resources, improves transition quality, and/or reduces user frustration would be obvious. This cannot be the standard. The Examiner cannot just locate each of the recitations of the claims in two or more references, combine them and then justify the combination. The motivation to combine the references must be obvious (clear and particular) without using Appellants' disclosure as a road map. Accordingly, Appellants respectfully submit that Claims 12, 13 and 17 are separately patentable for at least these additional reasons.

D. Claims 4, 6, 21 and 22

The Examiner's Answer contends that hindsight reasoning was not used in the rejection of these claims. The Examiner's Answer states:

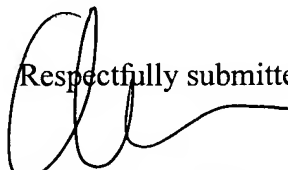
Mackin and Weschler are analogous art because they are both concerned with the same field of endeavor, namely a method to programmatically configure a new software application. Therefore, at the time the invention was made, it would have been obvious to someone of ordinary skill in the art, to combine plug-in modules with Mackins method of configuring an application. The motivation to do so would have been to enhance, override or overload basic functionality and behavior of an existing program

implemented as built-in functions. (Weschler, Column 11, lines 20). Furthermore, Mackin teaches plug-in modules to increase functionality as well. (Column 6, lines 16-22)

See Examiner's Answer, page 11. Again, Appellants respectfully submit that the case law is clear that the motivation to combine must be clear and particular. If this motivation provided by the Examiner were adequate then any modification that would enhance, override or overload basic functionality and behavior of an existing program implemented as built-in functions would be obvious. This cannot be the standard. The Examiner cannot just locate each of the recitations of the claims in two or more references, combine them and then justify the combination. The motivation to combine the references must be obvious (clear and particular) without using Appellants' disclosure as a road map. Accordingly, Appellants respectfully submit that Claims 4, 6, 21 and 22 are separately patentable for at least these additional reasons.

III. Conclusion

For the reasons set forth in above and in Appellants' Brief on Appeal, Appellants request reversal of the rejections of the claims, allowance of the claims and passing of the application to issue.


Respectfully submitted,
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